

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on July 25, 2002.

Claims 11, 14 and 35 are amended; as a result, claims 1, 3, 4, 11, 13, 14, 26-29, 34 and 35 are now pending in this application. The amendments to claims 11 and 14 are to correct the dependency as these claims were dependent on cancelled claim 31. The amendment to claim 35 is to correct a clerical error. No new subject matter is added.

Obviousness-type Double Patenting Rejection

Claims 1, 3, 4, 11, 13, 14, 26-29, 34, and 35 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1, 4-6, 10, 12, and 20 of co-pending Application No. 09/360,020, now issued as U.S. Patent No. 6,545,034. The Examiner asserts that although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim are directed to treating multiple myeloma (MM) while the co-pending claims are directed to treating leukemia. This rejection is respectfully traversed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. However, Applicants submit that the rejection for obviousness-type double patenting is in error as a person skilled in the art would not be motivated to treat multiple myeloma with a drug that was known to be an anti-leukemia drug.

The Examiner's rejection is based on the Applicants' remark in Paper No. 10, page 4, lines 4 and 5 that "both chronic lymphocytic leukemia and multiple myeloma can be considered leukemias". Thus, the Examiner concluded that "claims to treating leukemia are not patentably distinct from claims to treating a form of leukemia, *i.e.*, multiple myeloma." However, the Examiner's conclusion is not supported by applicants' statement. There is no evidence of record that one skilled in the art would have reasonably believed that the compounds of formula I would be useful for treating multiple myeloma based on applicants' statement. The phrase was taken out of context.

In support of their position applicants submit a declaration from Dr. Carlos J. Carrera. In his declaration, Dr. Carrera states that drugs which are effective for the treatment of some forms of leukemia are not generally effective for the treatment of multiple myeloma. Thus, because of the different etiologies of leukemias and multiple myeloma, a person skilled in the art would not be led to use or expect that a drug that was known to be an anti-leukemia drug would be useful for the treatment of multiple myeloma. Therefore, applicants respectfully submit that the instant claims are patentably distinct from the claims of U.S. Patent No. 6,545,034. Accordingly, it is respectfully requested that the rejection for obviousness-type double patenting be withdrawn.

§112 Rejection of the Claims

Claims 11 and 14 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 11 and 14 were alleged to be improperly dependent upon cancelled claim 31.

Applicants have amended the dependency of claims 11 and 14. These claims now depend on claim 35. In view of the amendment herein, it is respectfully requested that the rejection under 35 U.S.C. § 112 be withdrawn.

AMENDMENT & RESPONSE UNDER 37 C.F.R. § 1.116 - EXPEDITED PROCEDURE

Serial Number: 09/589,476

Filing Date: June 7, 2000

Title: USE OF ETODOLAC IN THE TREATMENT OF CANCER

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Dkt: 103.021US1

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612 373-6968) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date April 28, 2003 By William F. Prout
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Box AF, Commissioner of Patents, Washington, D.C. 20231, on this 28th day of April, 2003.

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